

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Mukai** §
Serial No. **09/965,940** § Group Art Unit: **2142**
Filed: **September 27, 2001** § Examiner: **Vu, Thong H.**
For: **Method and System for Music** §
Distribution §

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

36736
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on June 1, 2006.

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0461. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-22

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 2, 7, 11, and 19
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1, 3-6, 8-10, 12-18 and 20-22
4. Claims allowed: None
5. Claims rejected: 1, 3-6, 8-10, 12-18 and 20-22
6. Claims objected to: None

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 3-6, 8-10, and 12-18

STATUS OF AMENDMENTS

An accompanying amendment to cancel claims 20-22 has not yet been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 1 - INDEPENDENT

Claim 1 is directed to a method for downloading music for one or more pieces that are listed in a latest hits chart (**Figure 4**, page 9, line 16 through page 15, line 5). The method contains the following steps:

- receiving a request at a server, with the user requesting pieces with a given numerical ranking or above (step **75**, page 11, line 15 through page 12, line 19);
- selecting the pieces on the latest hits chart that have the requested numerical ranking or above (step **76**, page 12, line 20 through page 13, line 1);
- for each piece selected, determining associated data to be downloaded (page 13, lines 11-24);
- determining whether the selected data is already stored in the user's device (step **78**, page 13, lines 11-24); and
- downloading to the user, only the data that is not already stored in the user's device (step **78**, page 14, lines 8-19).

B. CLAIM 10 - INDEPENDENT

Claim 10 is directed to a music distribution system (**Figure 1**, page 6, line 16 through page 7, line 5) containing:

- a server for storing a lot of music data (reference number **14**, page 6, lines 16-24); and
- means to respond to a request from a user for downloading music pieces from the server that are included in a given latest hits chart (reference numbers **12**, **14**, **16**, page 6, line 16 through page 7, line 5), including:
 - means for receiving the request at said server, the request contains a number (reference numbers **12**, **14**, page 6, lines 16-24);
 - means for selecting music pieces from the latest hits chart that have rankings from 1 to the number (reference numbers **14**, **16**, page 6, line 16 through page 7, line 5);
 - for each musical piece selected, means for determining music data and associated data to be downloaded (reference numbers **14**, **16**, page 6, line 16 through page 7, line 5);

- means for determining whether music data to be downloaded are already stored in the user device (reference numbers **12, 14, 16**, page 6, line 16 through page 7, line 5); and
- means for downloading to the user device only music data that are not already stored in the user device (reference numbers **10, 12, 14, 16**, page 6, line 16 through page 7, line 5).

C. CLAIM 12 - DEPENDENT

Claim 12 is directed to the music distribution system of claim 10, where the downloading means downloads the latest hit charts list to the user device (reference numbers **10, 12, 14, 16**, page 6, line 16 through page 7, line 5).

D. CLAIM 13 - DEPENDENT

Claim 13 is directed to the music distribution system of claim 12, with additional means for updating a hit charts list of the user that is stored in the user device (reference numbers **10, 12, 14, 16**, page 6, line 16 through page 7, line 5).

E. CLAIM 14 - DEPENDENT

Claim 14 is directed to the music distribution system of claim 10, where the downloading means also deletes music in the user device that are not in the latest hit charts (reference numbers **10, 12, 14, 16**, page 6, line 16 through page 7, line 5).

F. CLAIM 15 - DEPENDENT

Claim 15 is directed to the music distribution system of claim 13, where the determining means includes means for comparing the titles of music pieces on the latest hit charts with the list on the user's version of the hit charts list (reference numbers **10, 12, 14, 16**, page 6, line 16 through page 7, line 5).

G. CLAIM 16 - DEPENDENT

Claim 16 is directed to the music distribution system of claim 15, wherein the determining means includes means for transmitting the user's hit charts list to the server, and the

comparing means is in the server (reference numbers **10, 12, 14, 16**, page 6, line 16 through page 7, line 5).

H. CLAIM 18 - DEPENDENT

Claim 18 is directed to the music distribution system of claim 10, in which

- the terminal is a portable terminal having a music playback function (page 8, lines 2-6),
- one or more downloading terminals are connected to the server via a network (page 18, lines 2-24),
- the determining means and selectively downloading means are in the downloading terminal (page 18, lines 2-24), and
- the portable terminal or a storage medium are loaded in the portable terminal for the downloading operation (page 18, lines 2-24).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. GROUND OF REJECTION 1 (Claims 1-22)

Whether Claims 1-22 are anticipated under § 102(b) by **Bernard** et al., System and Method for Automated Remote Previewing and Purchasing of Music, Video, Software, and Other Multimedia Products, U.S. Patent No. 5,918,213, June 29, 1999 (hereinafter “**Bernard**”).

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1, 3-6, 8-10, 12-18)

A.1. Claims 1, 3-6, 8-10, 12-17

Claim 1 is representative of the claim in this group and recites:

1. A music distribution method for downloading, in response to a request from a user, music data for one or more musical pieces included in a given latest hits chart from a server storing a lot of music data, comprising the steps of:

receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart;
on said given latest hits chart, selecting musical pieces that have a numerical ranking not greater than said chosen number;
for each musical piece selected, determining music data to be downloaded, said music data associated with respective selected musical pieces;
determining whether music data to be downloaded from said server are already stored in a terminal of said user; and
downloading, from said server to said terminal, only music data that are not stored in said terminal.

Regarding claim 1, the Final Office Action states:

6. As per claim 1, Bernard discloses a music distribution method for downloading, in response to a request from a user, music data for one more musical pieces (e.g.: top ten songs, specification, 0021) included in the given latest hit charts from a server storing a lot of music data [Bernard, Internet downloaded, col 23 lines 39-45; a listing of the top hits, col 29 lines 3-25] comprising the steps of:

Receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart [Bernard, catalog number, col 12 lines 1-18]

On said given latest hits chart, selecting musical pieces that have a numerical ranking NOT greater than chosen number [Bernard, top five hit list, col 35 line 56-col 37 line 26];

For each musical piece selected, determining music data to be downloaded, said music data associated with respective selected musical piece [Bernard, new music selections updates, col 20 lines 38-43;

determining if the information in database needs to be updated [Bernard, update database, col 24 lines 29-41]; and downloaded any new songs [Bernard, new music selections updates, col 20 lines 38-43]

determining whether music data to be downloaded from said server are already stored in a terminal said user and downloading, from said server to

said terminal, only music data that are not stored in said terminal (i.e.: update a new song) [Bernard, mapping information, col 29 lines 25-48; new music selections updates, col 20 lines 38- 43].

Final Office Action dated March 1, 2006, pages 3-4

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Bernard does not anticipate the invention recited in claim 1 because this reference does not identically show every feature of the claimed invention. Specifically, **Bernard** does not show both the step of “*receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart*” and the step of “*downloading, from said server to said terminal, only music data that are not stored in said terminal*”. Instead, in attempting to read **Bernard** on claim 1, the rejection has applied this reference to the claim in an inconsistent, and therefore improper, manner. Figure 1 of **Bernard** is reproduced below for reference.

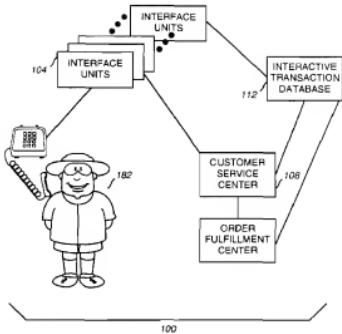


FIG. 1

interface units 104 (interface units 104 = user). Thus, between these two steps, both the apparent user and the apparent server change. In fact, interface units 104 are seen as the server in one step and as the user terminal in another. Support for this observation is detailed below.

The first step of claim 1 recites “*receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart*”. Appellants note that “*said request*” refers to the “*request from a user*” that is recited in the preamble. Against this step, the following section of **Bernard** is cited:

As stated above, in one embodiment the caller is provided the ability to listen to sample music selections by artist and title. The samples may include every track on an album, a selection of tracks from each album, or even a single track from an album. This feature is referred to as a Music Mall. In the Music Mall, callers can browse through the entire music inventory of the purchasing system. In the Music Mall, callers can choose what music they want to sample by categories such as, for example, Artist, Album Title, Catalog Number, Top-Selling Albums, and Specials. When the caller first connects with the music service, the caller is provided an audio menu by which he or she can make various selections. For example, the caller could choose to enter the Music Mall directly, where music titles can be purchased by Artist, Catalog Number, etc. Alternatively, the caller could choose to sample music featured by a local radio station, or top-selling albums in a particular style of music.

Bernard, column 12, lines 1-18

Claim 1 recites that a request comes to a server from a user, and in response, music data is sent from the server to the user. Against the step in claim 1 of receiving the request, the rejection cites a request sent from caller 182 (caller 182 = user) to interface units 104 (interface unit 104 = server). For the step in claim 1 that downloads music data from the server to the user terminal, the rejection cites the music data sent from interactive database 112 (interactive database 112 = server) to

Here, **Bernard** is speaking generally about the manner in which a customer or caller can approach the feature dubbed the Music Mall. The caller (the “user”) in this excerpt can request music pieces by their catalog number or can browse by citing a category, artist, or other attribute of the music. The recipient of the request is not specifically named in this paragraph, but column 14, lines 27-29 notes that “*interface units 104 provide an interface between the shopper and the functionality of the automated product purchasing system*”, thus defining that the request would be sent to interface units 104 (the “server”).

The final step of claim 1 recites “*downloading from said server to said terminal, only music data that are not stored in said terminal*”. Against these steps, the following excerpts are cited:

The example architecture allows for updating VRUs 104 via local area network (LAN) 408. In this manner, an operator is not required to replace hard drives on individual VRUs 104. A down load from a server on the LAN 408 allows new music selections and voice application updates to be easily loaded onto VRU 104.

Bernard, column 20, lines 38-43

Inventory updates to reflect new stock received and orders shipped are provided to interactive transaction database 112 via wide area network 412. In this manner, local instances of inventory information can be maintained within interactive transaction database 112, without the need for VRU site 460 to retrieve data from across the WAN 412 each time availability information is needed. As a result, when a caller 182 chooses to sample a particular title, interactive transaction database 112 can provide VRU 104 with availability information without the need to query fulfillment vendor 436 for each call. The inventory updates can be performed periodically (e.g., daily, weekly, hourly, etc.) depending on the system requirements.

Bernard, column 24, lines 29-41

3.2 Interactive Transaction Database 112 Data Types

Interactive transaction database data types are listed in FIG. 12 according to one embodiment of the invention. These data types include mapping information, customer information, order information, commission information, tax calculation data, credit calculation data, and profiling/cost statistics information.

Mapping information is used to provide information relating to geographic features of the automated product purchasing system. As described above, one feature of the automated product purchasing system is that it allows caller 182 to browse selections such as the featured artists, the top-hits list, and radio play lists for a particular radio station in the caller's geographic area. Determination

of the caller's geographic area is made using mapping information stored in interactive transaction database 112.

In one embodiment, the mapping information used is based on a radio metro area. The radio metro area is an area defined by the Arbitron Radio Service to define a particular radio area. This mapping information is not only used to tailor the caller's browsing to his or her geographic area, but can also be used to track album sales to a particular area, and to compile user preferences and other statistics based on the mapping area.

Bernard, column 29, lines 25-48

Unlike the earlier excerpts, here the "user" is VRU 104 and the "server" is interactive transaction database 112, as particularly seen in the second excerpt, which notes that "*interactive transaction database 112 can provide VRU 104 with availability information*". Clearly, this interpretation is not consistent with the earlier interpretation in which the "user" is caller 182 and the "server" is interface units 104. Just as it would be improper for Appellants to assign different meanings to a word when it is used in different steps of the claim, it is improper to shift the interpretation of elements within a single claim. Therefore, the user cannot be read on caller 182 in one step and on the VRUs 104 in another step within the same claim. At the very least, there must be consistency of meaning in a rejection. Appellants assert that **Bernard** cannot be properly read on both the step "*receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart*" and on the step "*downloading, from said server to said terminal, only music data that are not stored in said terminal*". This rejection should therefore be overturned.

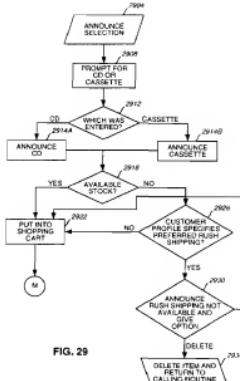
In addition to the discrepancy just discussed, the first step of claim 1 recites that the request from the user contains a number associated with a top hits chart. As the excerpts quoted above show, the rejection reads this chosen number on a catalog number for a music selection. Appellants note that the catalog number is not a number associated with a latest hits chart, as claimed. Instead, the catalog number is associated with a specific song or album and is the vendor's number assigned to the song or album. Additionally, many "catalog numbers" include letters, which does not make sense within the further recitations of the claim. **Bernard** does not disclose that the request contains a number associated with the latest hits chart. For this reason also, the rejection should be overturned

A.2. Claim 18

Claim 18 is the only claim in this group and provides additional features that are not shown in **Bernard** and which were not specifically addressed in the rejection. This claim recites:

18. The music distribution system according to claim 10, wherein said terminal is a portable terminal having a music playback function, one or more downloading terminals are connected to said server via a network, and said determining means and said selectively downloading means are provided in said downloading terminal to perform said determination and said selective downloading by connecting to said downloading terminal said portable terminal or a storage medium to be loaded in said portable terminal.

Claim 18 clearly recites that the terminal, defined in claim 10 as belonging to the user, is a portable terminal with a music playback function. Whether one reads the claimed user on **Bernard's** caller 182 or interface units 104, neither of these “users” download music data to a “portable terminal with a music playback function”. Interface units 104 are not designed to be portable and **Bernard** does not suggest that they could be. Additionally, caller 182 may have a portable machine with a music playback function, but **Bernard** does not suggest that the requested music is downloaded directly to the user’s machine. This is clear from Figure 29 of **Bernard**, reproduce below, which discusses steps taken when a user makes a selection.



Step 2908 in the flowchart shows a prompt for “CD or cassette”. No possibility is shown of directly downloading music. Instead, **Bernard** deals with CDs and cassettes, which are shipped to the user. This is not only true in this figure, but throughout the patent. **Bernard** sells CDs and cassettes, not downloadable music. **Bernard** thus does not disclose the features recited in claim 18. This rejection should be overturned.

The Board of Appeals is respectfully requested to overturn the rejection and indicate these claims to be allowable over **Bernard**.

/Betty Formby/
 Agent
 Reg. No. 36,536
YEE & ASSOCIATES, P.C.
 PO Box 802333
 Dallas, TX 75380
 (972) 385-8777

CLAIMS APPENDIX

The text of the claims involved in the appeal are:

1. A music distribution method for downloading, in response to a request from a user, music data for one or more musical pieces included in a given latest hits chart from a server storing a lot of music data, comprising the steps of:

receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart;

on said given latest hits chart, selecting musical pieces that have a numerical ranking not greater than said chosen number;

for each musical piece selected, determining music data to be downloaded, said music data associated with respective selected musical pieces;

determining whether music data to be downloaded from said server are already stored in a terminal of said user; and

downloading, from said server to said terminal, only music data that are not stored in said terminal.

3. The music distribution method according to claim 1, further comprising the steps of:

downloading a latest hit charts list including places, titles and singer names to said terminal from said server; and

updating a hit charts list of the user stored in said terminal based on said latest hit charts list.

4. The music distribution method according to claim 1, further comprising the step of deleting music data that are stored in said terminal and are not included in said latest hit charts.

5. The music distribution method according to claim 3, wherein said step of determining whether music data to be downloaded from said server are already stored in a terminal of said user includes the step of comparing the titles of musical pieces on said latest hit charts list with those on said hit charts list held in said user terminal.

6. The music distribution method according to claim 5, wherein said step of determining whether music data to be downloaded from said server are already stored in a terminal of said user includes the step of transmitting said hit charts list of said user to said server, which then performs said step of comparing the titles or musical pieces on said latest hit charts list with those on said hit charts list held in said user terminal.

8. The music distribution method according to claim 1, wherein said terminal is a portable terminal having a music playback function, one or more downloading terminals are connected to said server via a network, and said determining step and said downloading step are performed by connecting to said downloading terminal said portable terminal or a storage medium to be loaded in said portable terminal.

9. The music distribution method according to claim 8, further comprising the steps of: downloading a latest hit charts list including places, titles and singer names to said downloading terminals from said server; and

updating a hit charts list of the user stored in said portable terminal or said storage medium based on said latest hit charts list.

10. A music distribution system comprising:

a server for storing a lot of music data; and

means responsive to a request from a user for downloading, from said server, music data for one or more musical pieces included in a given latest hits chart, wherein said downloading means including:

means for receiving said request at said server, wherein said request contains a chosen number associated with a given latest hits chart;

means for selecting musical pieces from the given latest hits chart that have a numerical ranking not greater than said chosen number;

for each musical piece selected, means for determining music data to be downloaded, said music data associated with respective selected musical pieces;

means for determining whether music data to be downloaded from said server are already stored in a terminal of said user; and

means for selectively downloading, from said server to said terminal, only music data that are not stored in said terminal.

12. The music distribution system according to claim 10, wherein said downloading means downloads, from said server to said terminal, a latest hit charts list including places, titles and singer names, in addition to said music data.

13. The music distribution system according to claim 12, further comprising means for updating a hit charts list of the user stored in said terminal based on said latest hit charts list.
14. The music distribution system according to claim 10, wherein said downloading means deletes music data that are stored in said terminal and are not included in said latest hit charts.
15. The music distribution system according to claim 13, wherein said determining means includes means for comparing the titles of musical pieces on said latest hit charts list with those on said hit charts list of said user.
16. The music distribution system according to claim 15, wherein said determining means includes means for transmitting said hit charts list of said user to said server, and said comparing means is provided in said server.
17. The music distribution system according to claim 10, wherein said terminal is a personal computer.
18. The music distribution system according to claim 10, wherein said terminal is a portable terminal having a music playback function, one or more downloading terminals are connected to said server via a network, and said determining means and said selectively downloading means are provided in said downloading terminal to perform said determination and said selective downloading by connecting to said downloading terminal said portable terminal or a storage medium to be loaded in said portable terminal.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.